

### **REMARKS**

In an Office Action dated June 22, 2010, the Examiner rejects Claims 28-60 under 35 USC § 102(b) as being anticipated by US Pat. No. 5,758,160 issued to McInerney et al. ("McInerney"). The Examiner objects to Claim 51 under 37 CFR §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner also objects to the specification because the abstract recites reference numerals from the drawings.

In this response, Applicant cancels without prejudice objectionable Claim 51 and amends the specification to conform the abstract in accordance with the Examiner's suggestions, and respectfully traverses the rejections. Nevertheless, in an effort to advance the prosecution of the application to allowance as quickly as possible, and without admitting the propriety of the rejections, Applicant amends independent Claims 28, 41, 46 and 55 to clarify that which Applicant regards as the invention. Applicant further cancels without prejudice Claims 33 and 56, and amends Claims 57-59 to depend from Claim 55 instead of canceled Claim 56. Claims 1-27 were previously canceled by way of preliminary amendment.

Applicant submits that the amendments are supported by the written specification and drawings as originally filed, and that no new matter has been added. Applicant respectfully requests reconsideration of remaining Claims 28-32, 34-55 and 57-60 in view of the amendments and arguments presented in detail below.

**SPECIFICATION OBJECTION**

The abstract is amended in accordance with the Examiner's suggestion rendering the objection moot. Applicant respectfully requests the withdrawal of the objection.

**CLAIM 51 OBJECTION**

Claim 51 is canceled without prejudice rendering the objection moot. Applicant respectfully requests the withdrawal of the objection.

**CLAIM REJECTIONS – 35 U.S.C. § 102**

Claims 28-60 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by McInerney. (Applicant notes that the Examiner appears to have incorrectly referred to Claim 28 as Claim 1 on Page 4 of the Office Action and requests clarification if that is not the case.)

The McInerney reference describes techniques for sequencing the compilation of components when performing an incremental build of a computer program. In rejecting the independent claims 28, 41, 46 and 55, the Examiner relies in particular on selected portions of McInerney (Abstract, lines 6-16, Fig. 9, Col. 12, lines 50-60, Col 13, lines 1-30, Col. 14, lines 44-50, Col. 16, lines 33-40, Col. 17, lines 9-14), that describe a compiler that supports the build process using a BuildState status indicator to keep track of the progress of the compilation of a component. The BuildState status indicator has values including "Compiled," "BeingCompiled," "NeedToCompile," "Uncertain," etc. Among other assertions, the Examiner argues that components having a BuildState status indicator of "Compiled" disclose the active source files recited in the claims, and further that components having a BuildState status indicator of "NeedToCompile" discloses the

inactive source files recited in the claims. (Office Action, 6/22/10, Page 4). Applicant disagrees.

The cited portions of McInerney upon which the Examiner relies merely disclose conventional techniques for an incremental build process in which the BuildState indicator is used to control the logic of compiling the components of a program. The BuildState of “Compiled” merely indicates that the component has been compiled, and reveals nothing about whether the component is active or inactive as that term is described and used in the instant application. Likewise, the BuildState status indicator of “NeedtoCompile” merely indicates that the component has yet to be compiled, and reveals nothing about whether the component is active or inactive as that term is described and used in the instant application.

Moreover, it is worth noting that a search of the entire McInerney reference reveals no use of the terms “active” and “inactive,” or such a distinction between source files as described in the instant application. Not surprisingly, then, there is also no discussion of the transfer of an inactive source file to an active source file as recited in the claims of the instant application.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). The elements must be arranged as required by the claim ... *In re*

*Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added). See, MPEP §2131 Anticipation.

Furthermore, as explained in *NetMoneyIn v. Verisign* (Fed Cir. 2008), because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’”

Applicant submits that the *McInerney* reference fails to disclose the limitations of the independent claims 28, 41, 46 and 55 “in as complete detail as is contained in the claim,” as required by *Richardson v. Suzuki Motor Co.* (868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989)). For at least this reason, Applicant submits that Claims 28, 41, 46 and 55 are allowable over *McInerney*. Claims 29-32, 34-40, 42-45, and 57-60 variously depend from allowable independent Claims 28, 41, 46 and 55 and are allowable for at least the same reasons. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 28-32, 34-55 and 57-60 under Section 102(b).

### CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, Claims 28-32, 34-55 and 57-60 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP**

October 22, 2010  
Date

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